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Paper No.

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FEB 04 2010

In re Application of :  
Lencki et al. : DECISION ON  
Application No. 09/748,359 : PETITION  
Filed: December 26, 2000 :  
Atty Docket No. CLC 00.20 :

This is in response to the SUPPLEMENT TO PETITION FOR SUSPENSION OF THE RULES UNDER 37 C.F.R. §1.183 filed December 5, 2008. This petition was recently forwarded to the undersigned for consideration.

The renewed petition under 37 CFR 1.183 is granted.

The above-identified application was filed on December 26, 2000. A 37 CFR 1.63 declaration signed by all of the inventors (Lencki, Henchey and Miller) was filed on December 26, 2000. On April 9, 2008, applicant filed under seal an inventor's declaration under rule 131 along with the initial petition for suspension of the rules to have the 1.131 declaration accepted without the signature of the inventors. Applicant stated that the 1.131 declaration was signed by David Gordon on behalf of the assignee of record.

By decision mailed September 25, 2008, applicant's petition to suspend the rules filed April 9, 2008 was granted. However, in the decision, it was noted that:

The declaration under 1.131 was submitted under seal. In reaching this favorable decision, it was necessary for the undersigned to know the precise contents of the declaration. The undersigned is relying on applicant's assertion that the 1.131 declaration was signed by David Gordon on behalf of the assignee. If the examiner determines upon review on the merits that the 1.131

declaration was not signed by David Gordon, then this matter should be returned to the undersigned for reconsideration.

In response thereto, applicant filed the instant supplemental paper. Therewith applicant submitted a declaration under 37 CFR 1.131 in a form executed by David A. Gordon, on behalf of assignee Choicelinx Corporation. Additionally, applicant submitted a showing of an additional presentation of the declaration under 37 CFR 1.131 to the inventors on October 13, 2008.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection."

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, applicant does not contend that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the proper parties to sign the 37 CFR 1.131 declaration include all of the joint inventors.

In order for a petition under 37 CFR 1.183 to be granted to waive the requirement that all of the joint inventors sign the 1.131 declaration, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

On instant petition, applicant has set forth the steps taken to obtain the signatures of the three inventors on the 1.131 declaration. Applicant has submitted adequate proof that the

1.131 declaration was presented by letter dated April 8, 2008 to each of the inventors and that the inventors have not responded to the request to sign the declaration. There is no evidence of record indicating that any of the mailings to inventors was returned as undeliverable. Further, applicant has submitted evidence of the presentation of the 1.131 declaration to the inventors on October 13, 2008. Accordingly, refusal to sign the declarations is inferred from the failure to respond.

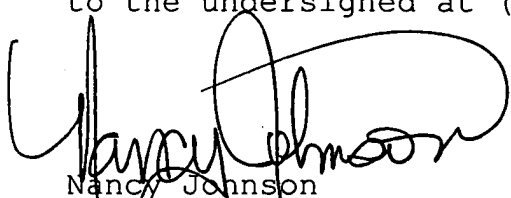
Applicant has provided a 1.131 declaration signed December 5, 2008 by David Gordon on behalf of the assignee. Applicant previously submitted a 3.73(b) statement establishing Mr. Gordon's authority to act on behalf of Choicelinx Corporation as assignee. An assignment of this application to Choicelinx Corporation executed by all three inventors is of record in the Office. Under the circumstances, it is concluded that petitioner has demonstrated that this is an extraordinary situation, warranting waiver of the rules.

The petition is granted to the extent that the 37 CFR 1.131 declaration filed December 5, 2008 may be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied. This is not a decision on the merits of the declaration or on any other evidence presented.

The \$400 fee required for consideration of this petition under § 1.183 was charged to Deposit Account No. 50-0310, on initial petition filed April 9, 2008.

Technology Center AU 3626 has been advised of this decision. The application is, thereby, forwarded to the Technology Center for further action by the examiner in light of this decision granting waiver of the requirement that all of the inventors sign the 1.131 declaration.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read 'Nancy Johnson', is written over the typed name.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions